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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,524	07/12/2000	Masahiko Sato	450100-02614	2008
20999	7590	01/18/2006	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			RODRIGUEZ, GLENDA P	
		ART UNIT	PAPER NUMBER	2651
DATE MAILED: 01/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/614,524	SATO, MASAHIKO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Glenda P. Rodriguez	2651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 16-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1.) Certified copies of the priority documents have been received.  
 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (US Patent No. 6, 064, 796).

Regarding Claim 16, Nakamura et al. teach a recording method comprising:

Receiving audio/video data to be written to a recording medium (Col. 3, L. 8-13);

Encoding said audio/video data using a given encoding method (Col. 3, L. 14-25);

Receiving a decoding program, wherein said decoding program is configured in a reverse process from said given encoding method such that said decoding program is capable of decoding said encoded audio/video data (Col. 3, L. 8-25);

and

Writing both said encoded audio/video data and said decoding program onto said recording medium (Col. 3, L. 8-25, it is obvious that by having the encoding method, you have the decoding method because by knowing the decoding method, you equivalently have the decoding method.).

Claim (19) has limitations similar to those treated in the above rejection, and is met by the references as discussed above. Claim (19) however also recites the following limitations

"Nakamura et al. further teaches comprising writing said decoding program to storage means coupled to said recording medium (See Summary)".

Apparatus claim (20 and 21) are drawn to the apparatus corresponding to the method of using same as claimed in claims (16 and 19). Therefore apparatus claims (20 and 21) correspond to method claims (16 and 19), and are rejected for the same reasons of obviousness as used above.

Claims (22 and 23) have limitations similar to those treated in the above rejection, and are met by the references as discussed above. Claims (22 and 23) however also recites the following limitations "Reading said audio/video data written on said recording medium (Col. 3, L. 47-50); Reading said decoding program written on said recording medium (Col. 3, L. 29-65); And decoding said audio/video data using said decoding program (Col. 3, L. 29-65)".

Regarding Claim 24, Nakamura teaches a recording/reproducing apparatus comprising:

First receiving means for receiving audio/video data to be written to a recording medium (Element 109);

Encoding means for encoding said audio/video data using a given encoding method See Description of Figure 1, Element 107);

Second receiving means for receiving a decoding program (See Summary and Description of Figure 1), wherein said decoding program is configured in a reverse process from said given encoding method such that said decoding program is capable of decoding said encoded audio/video data;

Writing means for writing both said audio/video data and said decoding program onto said recording medium (Col. 3, L. 8-25, it is obvious that by having the

encoding method, you have the decoding method because by knowing the decoding method, you equivalently have the decoding method.);

First reading means for reading said audio/video data written on said recording medium (See Element 116 and 608, wherein the audio/video data is outputted);

Second reading means for reading said decoding program written on said recording medium (Element 113 sends the decoding program data in order to select the decoding data that will decode the audio/video data); and

Decoding means for decoding said audio/video data using said decoding program (Element 112 with its description).

Regarding Claim 17, Nakamura et al. teaches all the limitations of Claim 16. Nakamura et al. further teaches wherein said writing both said audio/video data and said decoding program includes writing said audio/video data and said decoding program onto oblique recording tracks (See Summary of Nakamura et al.).

Regarding Claim 18, Nakamura et al. teaches all the limitations of Claim 16. Nakamura et al. further teaches comprising writing said decoding program to storage means coupled to said recording medium (See Summary).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenda P. Rodriguez whose telephone number is (571) 272-7561. The examiner can normally be reached on Monday thru Thursday: 7:00-5:00; alternate Friday.

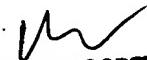
Art Unit: 2651

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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01/13/06.



DAVID HUDSPETH  
SUPERVISORY PATENT EXAMINER  
*...for the above case*